

Appln. No. 10/685,166
Amendment dated December 8, 2008
Reply to Office Action mailed September 8, 2008

REMARKS

Reconsideration is respectfully requested.

Claims 21 through 55 and 57 through 88 remain in this application. Claims 1 through 20 and 56 have been cancelled. No claims have been withdrawn or added.

Paragraphs 4 through 11 of the Office Action

Claims 21, 22, 25 through 28, 30, 32 through 37, 43, 44, 49 through 52, 82 and 83 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Killian in view of Ismail, Knudson, Yuen and Fuchigami.

Claims 23, 24, 38, 45, 48, 84 and 85 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Killian, Ismail, Knudson, Yuen and Fuchigami as applied to claims 21, 37, 43 and 82 above, and further in view of Herz.

Claims 40 through 42 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Killian, Ismail, Knudson, Yuen and Fuchigami as applied to claims 37 and 40 above, and further in view of Vogel.

Claims 39, 46 and 47 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Killian, Ismail, Knudson, Yuen and Fuchigami as applied to claims 37 and 43 above, and further in view of Scarampi.

Claims 29, 31, 53 through 55 and 57 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Killian, Ismail, Knudson, Yuen and Fuchigami as applied to claim 28 above, and further in view of Terakado.

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Claims 58, 59, 61 through 66, 76 through 78, 80, 81 and 86 through 88 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Killian in view of, Ismail, Knudson and Fuchigami.

Claims 60, 67 through 69, 73 through 75 and 79 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Killian, Ismail, Knudson and Fuchigami as applied to claim 58 above, and further in view of Yuen.

Claims 70 through 72 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Killian, Ismail, Knudson, Fuchigami and Yuen as applied to claim 69 above, and further in view of Terakado.

Claim 21 requires, in part, "monitoring the time and then determining whether the present time is the predetermined time" and "in the event the present time is the predetermined time, notifying the user that the program is to be recorded and confirming whether the program should be recorded". Claims 43, 58, 77, 82 and 86 include similar requirements.

In the rejection, it is conceded that:

However, Killian and Ismail et al. fail to specifically disclose monitoring the time and then determining whether the present time is the predetermined time, notifying the user that the program is to be recorded and confirming whether the program should be recorded and organizing the recorded program in a program library such that a user may select the program from the program library and view the recorded program at an appropriate time.

It is then contended that:

Knudson et al. discloses notifying the user that the program is to be recorded and confirming whether the program should be recorded (see cited portion, but not limited to col. 2, lines 58-col. 3, line 5).

And it is further asserted that:

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Killian and Ismail et al.'s invention with the above mentioned limitation as

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taught by Knudson et al. for the advantage of ensuring the user desires to have the program recorded and to prevent the needless recording of the program if the user is not interested.

However, looking to the Knutson patent, and in particular the portions of the Knutson patent that have been cited in the rejection, it is submitted that one of ordinary skill in the art, considering the Killian and Knutson patents, would not find it obvious to arrive at the claimed features of the invention. More specifically, the system discussed in the Killian patent is a system for scheduling and recording a program without requiring the intervention of the user. See, for example, Killian at col. 17, lines 36 through 56 (emphasis added):

In accordance with the comparison performed at step 306, suggest module 76 generates recording information for the program at step 308. For example, if a program for which database 48 contains program listing information 6 satisfies a predetermined threshold score associated with viewer profile 84, then suggest module 76 may generate the recording information for the program to cause the program to be recorded.

The recording information may include any instruction or set of instructions suitable to cause recorder 20 to record the program, such as an air date, start time, stop time, channel, or other information relating to the airing of the program. The present invention contemplates the recording information being an instruction to EPG API 60, control API 60, or another component of platform 12 to initiate recording of the program. At step 310, suggest module 76, control module 72, or another component of EPG 70 communicates the recording information for the program to EPG API 60, control API 60, or any other appropriate component of platform 12 or system 2 to instruct recorder 20 to record the program, and the method ends.

In this portion of the Killian patent, which is a portion of the text relied upon in the rejection, and especially in the highlighted sections of this portion, the Killian patent sets forth a process for selecting and recording a program that does not include any apparent actions by a user.

In contrast, the Knutson patent discusses a system in which the user of the system selects and schedules the recording of a program. See, for

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example, Knutson at col. 7, lines 4 through 19, which states (emphasis added):

At step 68, the user is provided with an opportunity to select a program for recording from the program guide. For example, the user may position highlight region 62 (FIG. 2) on top of a desired program entry in program listings grid 60 (FIG. 2) and press the "record" button on remote control 56 (FIG. 1). Just before the scheduled broadcast time of the selected program, a message is displayed on television 44 (FIG. 1) that informs the user that recording is about to begin (step 70). The message asks whether the user desires to continue with the recording of the selected television program. If the user indicates a desire to discontinue the recording of the program in response to the message of step 70, the recording of the program is cancelled at step 72.

As can be appreciated from the text above, particularly the highlighted text, the Knutson system is significantly different from the Killian system in that it is the user that selects the program to be recorded, and then issues the record command, in order for the Knutson system to cause a program to be recorded.

The rejection states that the motivation for making the allegedly obvious combination of Knutson with Killian is to "ensur[e] the user desires to have the program recorded and to prevent the needless recording of the program if the user is not interested". However, the Knutson system does not use this process to determine if "the user desires to have the program recorded", or to "prevent the needless recording of the program if the user is not interested", as asserted in the rejection, and in fact does not perform these functions. Why? Because, if the user does not respond, the Knutson system records the program anyway. See, for example, Knutson at col. 7, lines 27 through 40, where it states that (emphasis added):

If the user does not respond to the message of step 70, it is assumed that the user is not present and that the TV/VCR is therefore off. Accordingly, at step 76, control circuitry 36 directs circuitry 38 to tune to the appropriate channel for recording the selected program, directs videocassette recorder 42 of TV/VCR unit 48 to turn on by transmitting a "turn on" command to infrared receiver 54 of TV/VCR 48 with infrared transmitter 52, and directs videocassette recorder 42

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of TV/VCR unit 48 to begin recording by transmitting a "record" command to infrared receiver 54 of TV/VCR 48 with infrared transmitter 52. When the selected program is over, recording may be terminated by transmitting "stop" and "off" commands to TV/VCR unit 48.

Therefore, it is submitted that one of ordinary skill in the art, considering the Killian and Knutson patents, would not be motivated to make the allegedly obvious combination set forth in the rejection, at least for the purpose set forth in the rejection. Moreover, this purpose, or "problem" that is contented to be solved by the allegedly obvious combination, is not mentioned in any of the cited art.

It is further conceded in the rejection that:

However, Killian, Ismail et al., Knudson et al. and Yuen et al. fails to specifically disclose monitoring the time and then determining whether the present time is the predetermined time.

It is then asserted that:

Fuchigami discloses monitoring the time and then determining whether the present time is the predetermined time (see cited portion, but not limited to col. 24, lines 13-27).

And it is further contended that:

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Killian, Ismail et al., Knudson et al. and Yuen et al.'s invention with the above mentioned limitation as taught by Fuchigami for the advantage of recording the program at the appropriate time.

However, the system discussed in the Fuchigami patent is directed to email communications, and more specifically, the initiation of a dial-up connection, not to the recording of a previously selected and scheduled program. It is submitted that one of ordinary skill in the art, considering the Fuchigami patent, would not find it obvious to apply this to the system of the Killian patent, particularly the allegedly obvious combination of documents relied upon in the rejection of the Office Action.

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Claim 35 requires that "in the event no program is identified, searching electronic program guide data periodically". The rejection of claim 35 points to Killian at col. 4, lines 7 through 20, which states:

An electronic programming guide (EPG) JAVA applet or application running on platform 12 periodically accesses database 48 using link 14 and server 46 to receive program listing information 6 that allows the EPG applet or application to provide television-related functionalities to viewers associated with receiver 10 and television 40, as discussed more fully below with reference to FIG. 3. Although database 48 is discussed, the present invention contemplates a suitable database integral to receiver 10 and periodically updated by one or more service providers external to receiver 10 using link 14, for example, daily, weekly, or on any other periodic basis, to include program listing information 6 accessible to platform 12.

However, it is submitted that this portion of the Killian patent merely refers to the periodic downloading of the information to the EPG, it does not disclose periodically performing a search of the EPG, especially in the context of "the event [in which] no program is identified", as required by claim 35.

Claim 36 requires that "in the event no program is identified, searching electronic program guide data upon receiving an update of electronic program guide data." It is alleged in the rejection that this feature of the claimed invention is disclosed by Killian at col. 8, lines 49 through 56, which states:

The present invention contemplates storing program listing information 6 locally at receiver 10 and periodically updating program listing information 6 to replace or combine with accessing database 48 using link 14. In general, EPG 70 allows a viewer to more intelligently select, schedule, and record viewing opportunities according to program listing information 6 and a viewer profile associated with the viewer.

However, it is submitted that this portion of the Killian patent merely refers to "periodically updating program listing information", but does not disclose "searching electronic program guide data upon receiving an update of electronic program guide data", especially "in the event no program is

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identified". This portion merely discusses generally the benefits of an EPG, and mentions that the EPG is periodically updated, but is silent regarding any connection between the updating of the EPG and any searching of the EPG.

It is therefore submitted that the cited patents, and especially the various allegedly obvious combinations of Killian, Ismail, Knudson, Yuen, Fuchigami, Herz, Vogel, Scarampi, and Terakado set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 21, 43, 58, 77, 82 and 86.

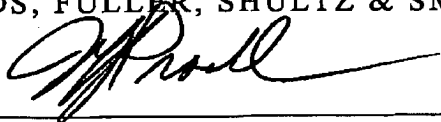
Withdrawal of the §103(a) rejection of claims 21 through 55 and 57 through 88 is therefore respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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